

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 55-69 are pending in the present application, Claims 55, 56, 58, 60, 61, 63, 65, 66, and 68 having been amended. Support for the amendments to Claims 55, 56, 58, 60, 61, 63, 65, 66, and 68 is found, for example, in the specification on pages 80-115. Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, the abstract was objected to; and Claims 55-69 were rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention; and Claims 55-69 were rejected under 35 U.S.C. §103(a) as unpatentable over Jackson (U.S. Patent No. 5,960,444) in view of Schloss (U.S. Patent No. 6,249,844).

With respect to the objection to the abstract, a new abstract is provided. The outstanding Office Action does not specifically identify the deficiencies believed to be in the prior Abstract. The outstanding Office Action merely reminds applicant of the proper language and format for an Abstract. Applicant respectfully submits that the new Abstract complies with the requirements for an Abstract. If the Examiner should disagree, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to draft a mutually satisfactory Abstract.

With respect to the rejection of Claims 55-69 under 35 U.S.C. §112, second paragraph, Applicants respectfully traverse the rejection.

The outstanding Office Action misconstrues the remarks made in the Amendment filed on September 20, 2006. The outstanding Office Action forgets that the document created by combining the plurality of documents is renamed. Thus, the statement on page 4 of the Office Action “the name (C) of document C is used as a file name of documents A and B” is incorrect. Document (C) was renamed to A, and A is used to designate the coupled

document data post-processing. Furthermore, the outstanding Office Action, for some unexplained reason, sees fit to try to use a mathematical expression to compare pre-processing and post-processing situations. However, the way the document names change after the processing is not correctly stated. The correct result should be expressed as A couple $B = C$, and then A-1 couple $A-2 = A$, where as result of the processing, A is renamed to A-1, B is renamed to A-2, and C is renamed to A. A and B are renamed based on the new name assigned to the result of the coupling of the document data. However, Applicants consider this discussion to be moot in view of the present amendment to the claims.

Furthermore, the present claims define the invention, and there is support for the amended claims in the originally filed specification at page 83, line 25 to page 87, line 10.

Accordingly, this ground for rejection is believed to have been overcome. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually satisfactory claim language.

With respect to the objection to the claims, the claims are amended to overcome this ground of rejection.

With respect to the rejection of Claim 55 as unpatentable over Jackson in view of Schloss, Applicants respectfully traverse the rejection. Amended Claim 55 recites, *inter alia*, “a document name generating part configured to determine a name of one of the plurality of document data used to create the first document data, to assign the determined name of one of the plurality of document data used to create the first document data to the first document data, and to rename the plurality of document data used to create the first document data so as to include the name assigned to the first document data.” The combination of the Jackson and Schloss do not disclose or suggest this element of Claim 55.

Jackson is directed toward a software tool that allows a user to combine a number of smaller documents and then to index the combined documents. A bookfile contains one or

more documents. The software tool combines the documents and generates a master index for all the documents. The software tool also allows the user to specify abbreviations and long titles to use in the index generated for each bookfile.¹

Jackson discloses that setup data is used to generate abbreviation information 401 of Figs. 4(a) and 4(c) and title information 407 of Fig. 4(c).² However, the setup data (shown in Fig.3, items 308 and 310, of Jackson) is entered by the user. The system in Jackson just continues to use the user provided name and abbreviation. The name and abbreviation shown in Fig. 4(c) of Jackson is not based on any documents used to create the particular document.

Thus, Jackson does not disclose or suggest a document name generating part configured to determine a name of one of the plurality of document data used to create the first document data, to assign the determined name of one of the plurality of document data used to create the first document data to the first document data, and to rename the plurality of document data used to create the first document data so as to include the name assigned to the first document data.

Furthermore, Schloss does not cure the above-noted deficiency in Jackson. Schloss merely discloses a way to create a unique name for a fragment.

Applicants respectfully submit that the outstanding rejection is deficient to the extent it relies upon *In re Gulack* 217 U.S.P.Q. 401, 404 (Fed. Cir. 1983) and/or *In re Lowry* 32 U.S.P.Q.2nd 1031 (Fed. Cir. 1994).

The Office Action relies upon *In re Gulack* and/or *In re Lowry* to support an obviousness rejection. Applicants note that the cases cited by the Examiner relate to printed matter as a basis for patentability.

As *In re Gulack* relates to descriptive material presented on a substrate for determining patentability, *In re Gulack* is wholly unrelated to the Applicants' claims. The nonfunctional descriptive written material distinguished in *In re Gulack* is only deemed

¹ Jackson, Abstract.

² Jackson, col. 4, lines 13-15.

nonfunctional as it relates to the patentability of a substrate. Simply stated, this case makes it clear that what is written on a substrate will not distinguish the invention from the prior art in terms of patentability of the substrate. It is unclear why the Official Action recites this case as the present claims are not directed toward writing material on a substrate.

Applicants note that the Office Action has cited the above cases in support of a proposition that the names assigned to the document data are somehow nonfunctional descriptive material. However, the actual names of the documents (i.e., “Applie Pie Recipe.doc”) are not being claimed. Of course, a name assigned to the first document data in Applicants’ system is a name of one of the plurality of document data used to create the first document data. The configuration to determine, assign, and rename document data further limits claims. This is in stark contrast to a mere font of typeface, as discussed in the cited case law. The Office Action has mischaracterized these cases as having anything to do with the configuration of an electronic system to process and couple specific document data in accordance with the recitation of the Applicants’ claims. Accordingly, Applicants submit that this rejection is deficient, and should be withdrawn, at least, for this reason alone.

Furthermore, the citation to case law relating to “non-functional descriptive material” is more properly applied in cases which recite executable code listings on a substrate, not to apparatus and method claims.

In view of the above-noted distinctions, Applicants respectfully submit that Claim 55 (and any claims dependent thereon) patentably distinguishes over Jackson and Schloss, taken alone or in proper combination. Furthermore, Claims 60 and 65 recite elements analogous to those of Claim 55. Thus, Applicants respectfully submit that Claim 60 and 65 (and any claims dependent thereon) patentably distinguishes over Jackson and Schloss, taken alone or in proper combination, at least for the reasons stated for Claim 55.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

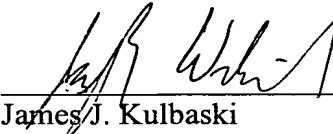
Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Joseph Wrkich
Registration No. 53,796